

PTO/PCT Rec'd 09 APR 1999

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of
GERHAEUSER et al.
Application No.: 08/676,355
PCT No.: PCT/DE95/00055
International Filing Date: 16 January 1995
Priority Date: 19 January 1994
For: Method of Determining the Receptivity
of Wireless Signals in a Broadcast System

86 Sparks Street
Cambridge, MA 02138-2216
6 April 1999

Hon.
Assistant Commissioner for Patents
Box PCT
Washington, DC 20231

Attention: PCT Legal Office

Second Renewed Petition Pursuant to 37 C.F.R. 1.137(a)

Sir:

This renewed petition for the revival of the instant application due to an unavoidable delay in the prosecution thereof is being filed in pursuance of the decision dated 8 January 1999. A request for an extension of time and the requisite fee have been submitted under separate cover.

DISCUSSION

The application was filed on 19 July 1996 without an executed inventors' declaration, and became unavoidably abandoned because of the loss by the Patent and Trademark Office, as conceded by Miss Vonda M Wallace of the PCT Section to the undersigned attorney by telephone on or about 29 April 1997, of the subsequently submitted inventors' executed declaration and power of attorney. That declaration was sent to the PTO under cover of the undersigned attorney's letter dated 30 July 1996 and a

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Certificate of Mailing under 37 C.F.R. 1.8, and was accompanied by Assignee Fraunhofer's Verified Statement (Declaration) Claiming Small Entity Status, an Assignment with cover sheet for recording *as well as by now canceled check No. 4329 collected by the PTO on 13 September 1996 and bearing an unambiguous reference to Application No. 08/676,355.* The check (copy enclosed) was in the amount of \$105.00 to cover the fees under 37 C.F.R. 1.16(e) and 37 C.F.R. 1.21(h). The submission was also accompanied by a request for a refund of the excess paid for commencing the nationalization of the instant application, and by a post card receipt deemed defective by the PTO because it failed to identify the application by number. Even though reasonable men would conclude that receipt and collection by the PTO of the attorney's check No. 4329 dated 30 July 1996 is clear and convincing evidence that the attorney's letter of the same date and all its enclosures were in fact received by the PTO, the Patent and Trademark Office has insisted that the instant application became abandoned as of 4 October 1996, i.e. thirty (30) days after the mailing of its Notification of Missing Requirements, Form PCT/DO/EO/905.

Because of the proscription against alterations of any kind, the Declaration sent to the PTO on 30 July 1996 did, of course, not refer to the application number. That number was, however, clearly marked at the upper left hand corner of the attorney's cover letter as well as on the Attorney's Certificate of Mailing and on the check referred to above. Accordingly, the PTO should have had no difficulties matching the Declaration with the application file.

Contrary to the opinion set forth in paragraph 2 on page 3 of the Decision of 8 January 1999, Applicants did not question the propriety of the mailing of the Notification of Missing Requirements of 4 September 1996, for they at once responded to that Notification by letter of 17 September 1996 submitting a copy of their attorney's communication of 30 July 1996, in an

earnest effort to help solve a problem which arose in consequence of the Patent and Trademark Office having lost the declaration submitted with their attorney's letter of 30 July 1996. With respect, the fact that the PTO on 13 September 1996 collected the attorney's check accompanying the late submission of that declaration is clear and convincing evidence not only of the PTO having received that declaration but also of the fact that the abandonment of the application was entirely unavoidable by Applicants; for they had absolutely no control over what the PTO did with their properly submitted executed declaration, nor can they be held accountable for such loss.

Having regard to the Legal Examiner's observations in his Decision of 8 January 1999 about the alleged untimeliness of the submission of Applicants' new executed declaration, Applicants' attorney wishes to point out that the delay in submitting the inventors' new declaration by letter of 14 September 1998, subsequent to the timely filed Renewed Petition of 29 July 1998, was occasioned by the great difficulty in obtaining all inventors' signatures; for some of the inventors had left their previous employment and could not easily be located. The new declaration was received by the undersigned attorney on 14 September 1998 and was immediately forwarded to the PTO.

It is respectfully observed that in the circumstances described the new declaration could not have been submitted earlier. In fact, it would not have been necessary if the PTO had accorded the initially submitted and allegedly lost declaration the degree of care which would have prevented such loss.

Applicants are at a loss as to what they should have done in the circumstances described to avoid the abandonment of their instant application or what they can do to show in an acceptable manner that the delay in prosecuting this application was unavoidable in the circumstances described;

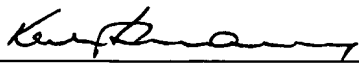
for it was through no fault of theirs that the PTO lost their initial declaration. Nor do Applicants understand the reason for a terminal disclaimer when, through no fault of theirs, the application became abandoned as a result of the PTO having lost Applicant's original late-filed declaration.

While Applicants will concede, *arguendo*, that the post card receipt which accompanied their Attorneys' submission of 30 July 1996 of their (first) executed declaration may for lack of mentioning the application number have been defective as evidence of submission, they contend, with respect, that their Attorney's canceled check No. 3429 of 30 July 1996 referring to that application by number and collected by the PTO on 13 September 1996 does indeed prove that the PTO received the documents submitted with that check.

Given the circumstances set forth above, Applicants urge that the delay in the prosecution of their instant application was entirely unavoidable by them, and having filed as soon as it was available, under date of 14 September 1998, a new declaration, they pray that their instant petition be granted and that their application be revived.

If in the opinion of the Legal Examiner the issues here earnestly urged to have been solved need further clarification, Applicants' counsel, in the interest of an efficient resolution, courteously requests an interview with the Legal Examiner at his convenience, either by telephone or in person.

Respectfully submitted,



Karl Hormann
Registration No.: 26,470

Enclosure
Area Code (617)-491-8867

CERTIFICATE OF MAILING BY FIRST CLASS MAIL (37 CFR 1.8)

Applicant(s): Gerhaeuser et al.

Docket No.

960160 #10

Serial No.

08/676,355

Filing Date

19 July 1996

Examiner

Cole, R.

Group Art Unit

PCT

Invention: Method of Determining the Receptivity of Wireless Signals in a Broadcast System

RECEIVED

10 APR 1999

Legal Staff
International DivisionI hereby certify that this Second Renewed Petition Pursuant to 37 C.F.R.1.137(a) dated 6 April 1999

(Identify type of correspondence)

is being deposited with the United States Postal Service as first class mail in an envelope addressed to: The

Assistant Commissioner for Patents, Washington, D.C. 20231 on

6 April 1999

(Date)

Karl Hormann

(Typed or Printed Name of Person Mailing Correspondence)



(Signature of Person Mailing Correspondence)

Note: Each paper must have its own certificate of mailing.

KARL HORMANN
86 SPARKS STREET
CAMBRIDGE, MA 02138

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